

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/606,796 Confirmation No. 5886
Applicant : DOILLON, Charles J., *et al*
Filed : June 27, 2003
TC/A.U. : 3738
Examiner : Javier G. Blanco

Docket No. : 14363
Customer No. : 000293

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450
U.S.A.

Dear Sir:

This letter is filed in response to the Office action of October 11, 2006 (*i.e.* Supplemental Restriction Requirement). The Applicants hereby elect the claims of Group I (claims 1 to 15, 25, 26 and 29 to 33), for further prosecution, **with traverse**. The Applicants reserve all rights in the non-elected claims, including the right to file one or more divisional applications covering the subject matter thereof.

By way of traversal, the Applicants submit that the inventive subject matter of Group II (claims 27 and 28) should be considered with that of Group I, as examination of both groups would not increase the burden upon the Examiner.

The Examiner indicated that the combination as claimed does not require the particulars of the subcombination as claimed because the membrane does not require to be hydrated. Further, the subcombination has separate utility such as a corneal implant packaged in a pre-hydrated state having no need for a rehydration solution.

The Applicants respectfully disagree.

MPEP 806.05(c) provides:

AB^{sp}/B^{sp} No Restriction

Where a combination is *as claimed* sets forth the details of the subcombination as *separately claimed*, there is no evidence that combination AB^{sp} is patentable without the details of B^{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB^{sp} ..., and subcombination B^{sp}. Thus the specific characteristics required by the subcombination claim B^{sp} are also required by the combination claim.

Claim 27 is dependent upon claim 1. Under U.S. patent law and practice, any dependent claim shall be construed as including all the limitations contained in the claim to which it refers. As such, the subject matter defined by claims 1 and 27 meets the criteria stipulated in MPEP 806.05(c) and therefore, a restriction requirement is improper.

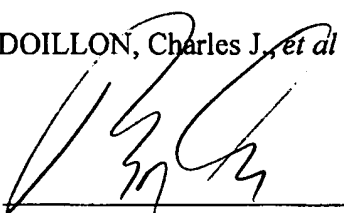
Referring to claim 28, although the commercial package comprises a hydrated corneal implant and a rehydration solution, the Applicants respectfully submit that a search for the corneal implant defined in the claims of Group I would necessarily include a complete search of the corneal implant defined in the claims of Group II. It is therefore submitted that the search and examination of the subject matter of Group I and Group II would not impose a burden on the Examiner.

Accordingly, reconsideration of the restriction requirement and examination of Group I and Group II are respectfully requested.

Respectfully submitted,

DOILLON, Charles J., *et al*

By:


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Date: October 23, 2006

MG:AEA:bbm:cad

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